

## **Remarks**

This Response is provided in response to a non-final Office Action mailed June 2, 2004. The Office Action rejected claim 16 under 35 U.S.C. §102(b) as being anticipated by prior art, and claim 22 has been withdrawn from consideration and has been canceled by the Applicant. The Office Action further provided certain objections to the specification and drawings.

This response provides amendments to the specification, drawings, and to dependent claim 3. Amendments to the third paragraph of page 4, starting at line number 22 and continuing through line 7 of page 5 of the specification of the present application, have been made to correct the typographical informality “newly10” to now read as “newly.”

Amendments to line 17 of page 6 of the specification of the present application have been made to correct the typographical informalities “3 and 4” to now read as “1 and 2.”

Amendments to line 22 of page 7 and continuing through line 1 of page 8 of the specification of the present application have been made to correct the typographical informality “14” to now read as “15.”

Amendments to line 5 of page 17 of the specification of the present application have been made to correct the typographical informality “72” to now read as “74.”

FIG. 13 has been amended to add reference numeral “98” as required by the Examiner. FIG. 17 has been amended to add reference numeral “68” and reference numeral “56” has been moved to show the outer female portion, instead of the inner male portion.

FIG. 26 has been amended to replace reference numeral “56F” with reference numeral “36F” to correct a typographical error.

Claim 3 has been amended to correct a typographical error of the double inclusion of the word “the.”

The hereinabove amendments are believed to be proper, do not introduce new matter, and further serve to place the application in proper condition for reconsideration and allowance.

The status of the claims in the application following entry of the present response will be as follows:

<b><u>Claim</u></b>	<b><u>Status</u></b>
1. (Previously Presented)	Independent.
2. (Previously Presented)	Dependent from 1.
3. (Currently Amended)	Dependent from 1.
4. (Previously Presented)	Independent.
5. (Previously Presented)	Dependent from 4.
6. (Previously Presented)	Dependent from 4.
7. (Previously Presented)	Dependent from 1.
8. (Previously Presented)	Independent.
9. (Previously Presented)	Dependent from 8.
10. (Previously Presented)	Dependent from 8.
11. (Previously Presented)	Independent.
12. (Previously Presented)	Dependent from 11.
13. (Previously Presented)	Dependent from 11.
14. (Previously Presented)	Dependent from 1.
15. (Previously Presented)	Independent.
16. (Previously Presented)	Independent.
17. (Previously Presented)	Dependent from 1.
18. (Previously Presented)	Dependent from 1.
19. (Previously Presented)	Dependent from 1.
20. (Previously Presented)	Dependent from 1.
21. (Previously Presented)	Independent.
22. (Canceled)	

### **Objection to the Drawings**

The Examiner has objected to the drawings for not showing a third radiused portion 98 as described in the specification on page 19, line 20. The amendments made to the drawings correlates subject matter shown in the drawings with the description of those drawings contained within the specification.

### **Objections to the Specification**

The Office Action objected to certain informalities of the application. In response, the Applicant has amended these informalities as discussed hereinabove, and believes that these amendments obviate the objections.

### **Rejection of Claim 16 Under 35 U.S.C. §102(b)**

The Office Action rejected claim 16 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,038,543 issued to Leo E. Neyer, August 13, 1991 (Neyer '543). This rejection is respectfully traversed.

Regarding independent claim 16, the Applicant respectfully points out that through the inclusion of the limitation “steps for forming a standing seam assembly with sidelap shear capacity,” claim 16 is drafted under the provisions of 35 U.S.C. §112, sixth paragraph. Under 35 U.S.C. §112, sixth paragraph, “*An element in a claim for a combination may be expressed as a means for **or step** for performing a specified function without recital of structure, material, **or acts** in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof*” (emphasis added).

The Examiner is respectfully reminded that the proper examination of claim 16 requires an identification of the corresponding structure, material, or **acts** in the specification and equivalents thereof, that carry out the functions recited in the claim, and that 35 U.S.C. §112, sixth paragraph, applies to the Examiner during prosecution of the patent application (emphasis added). *In re Donaldson Company, Inc.*, 16 F.3d 1189 at 1193, 1194 (Fed.Cir.1994) (*en banc*). Pursuant to 35 U.S.C. §112, sixth paragraph, “structure disclosed in the specification is ‘corresponding structure’ only if the specification **or prosecution history** clearly associates that structure to the function recited in the claim. This duty to link or associate structure to function is the *quid pro quo* for the convenience of employing 112, paragraph 6,” (emphasis added). *B. Braun Medical*, 43 USPQ2d 1896 at 1900.

In accordance with *B. Braun Medical*, *supra*, the Applicant respectfully associates the acts supporting the function called for by the “means plus function” claim element of claim 16, “steps for forming a standing seam assembly with sidelap shear capacity,” to include at least the steps of: jointly forming a fifth leg portion with a tang extending therefrom of a male sidelap portion of a first panel adjacent a second panel; pressing a downwardly angled leg with hook portion of the second panel into mating contact with the tang extending from the fifth leg portion and folding the resulting mated leg and tang into

adjacency with said fifth leg portion to form a standing seam; and downwardly forming the standing seam to create an acute angle with respect to a first leg portion of a female sidelap portion of the second panel to form the standing seam assembly with sidelap shear capacity.

Support for these acts may be found by referring to the specification as previously amended at page 15, line 7; page 16, line 1 and the specification as previously amended at page 18, line 5.

Accordingly, the Examiner is *obliged as a matter of law* to construe the structure, and equivalents thereof, as identified hereinabove by the Applicant, as acts supporting the recited function of the 35 U.S.C. §112, sixth paragraph, element of claim 16. *In re Donaldson Company, Inc.*, 16 F.3d 1189 at 1195 (Fed.Cir.1994) (*en banc*). See also *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, P6*, 65 FR 38510, Federal Register Vol. 65, No. 120, June 21, 2000; and *Means or Step Plus Function Limitation Under 35 U.S.C. 112, P6*, Notice, 1162 Off. Gaz. Pat. Office 59 (May 17, 1994).

By identifying the hereinabove acts, the Applicant has identified elements of claim 16. To support a rejection of independent combination claim 16 under 35 U.S.C. §102(b), Neyer '543 must identically show the acts, or equivalents thereof, that correspond to the elements identified by the Applicant as his invention. When the claim is properly construed, it is clear that Neyer '543 fails to identically show the acts, or equivalents thereof that correspond to the Applicant's claimed invention.

Indeed Neyer '543 is specifically silent on, and fails to disclose the steps, or equivalents thereof, of: jointly forming a fifth leg portion with a tang extending therefrom of a male sidelap portion of a first panel adjacent a second panel; pressing a downwardly angled leg with hook portion of the second panel into mating contact with the tang extending from the fifth leg portion and folding the resulting mated leg and tang into adjacency with said fifth leg portion to form a standing seam; and downwardly forming the standing seam to create an acute angle with respect to a first leg portion of a female sidelap portion of the second panel to form the standing seam assembly with sidelap shear capacity.

Accordingly, claim 16 defines subject matter that is patentable over the cited references and reconsideration and withdrawal of the rejection of claim 16 is respectfully requested.

### **Election/Restrictions**

The Applicant appreciates and understands the Examiner's perspective that claim 22 "does not include a first panel having a female sidelap portion with a downwardly angled leg and hook portion which presses in mating contact with the tang of an adjacent panel and which further folds the mated leg with hook and tang in adjacency with the fifth leg portion of the adjacent panel (Figure 6, Species B); instead, claim 22 cites a first panel with a downwardly angled leg portion without a hook portion, a second panel with a tang, wherein the angled leg and tang are pressed in mating contact and further upset crimped to increase frictional retention forces (Figure 22, Species I)." This restriction is respectfully traversed because both claims 1 and 22 are both assemblies that form a standing seam assembly with a sidelap shear capacity resistant to side slipping when subjected to applied forces.

### **Allowable Subject Matter**

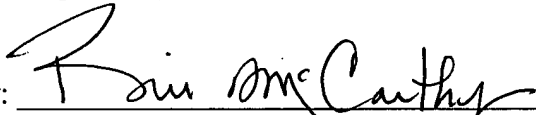
The Applicant wishes to express his appreciation for the Examiner's allowance of claims 1-15 and 17-21.

### **Conclusion**

The Applicant respectfully requests reconsideration and allowance of all the claims pending in the application. This Response is intended to be a complete response to the non-final Office Action mailed June 2, 2004.

Should any questions arise concerning this response, the Examiner is invited to contact the below listed Attorneys.

Respectfully submitted,

By: 

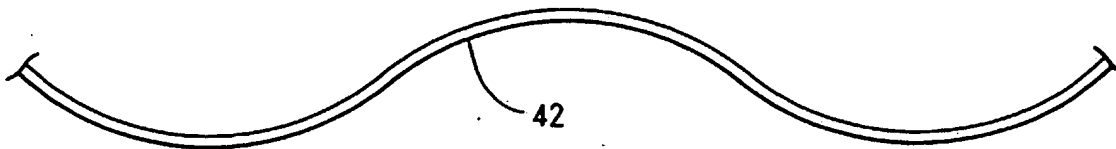
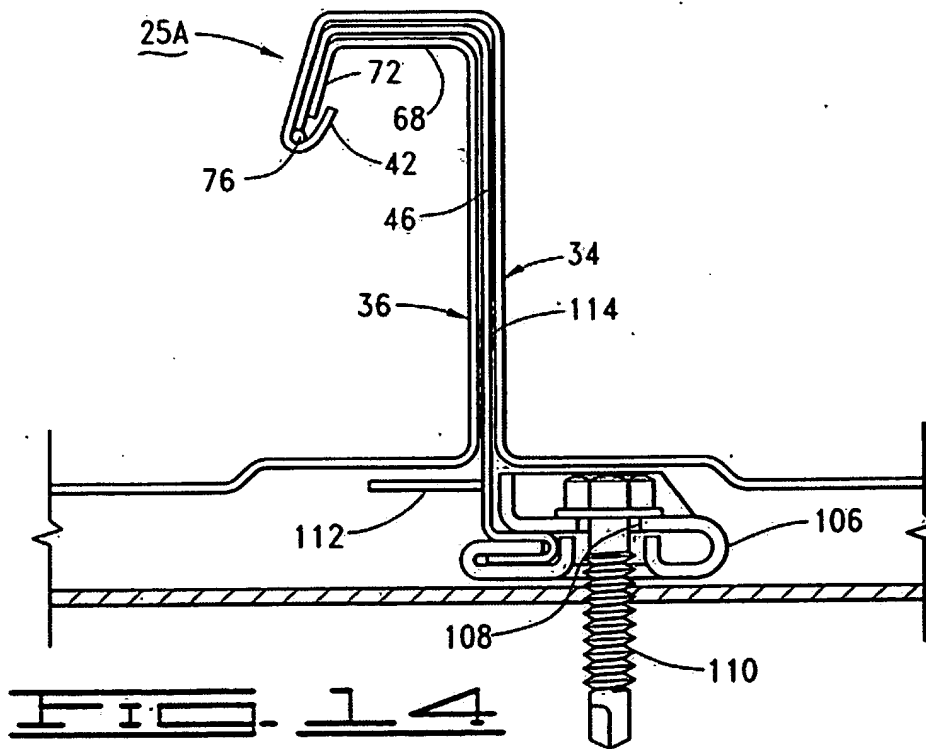
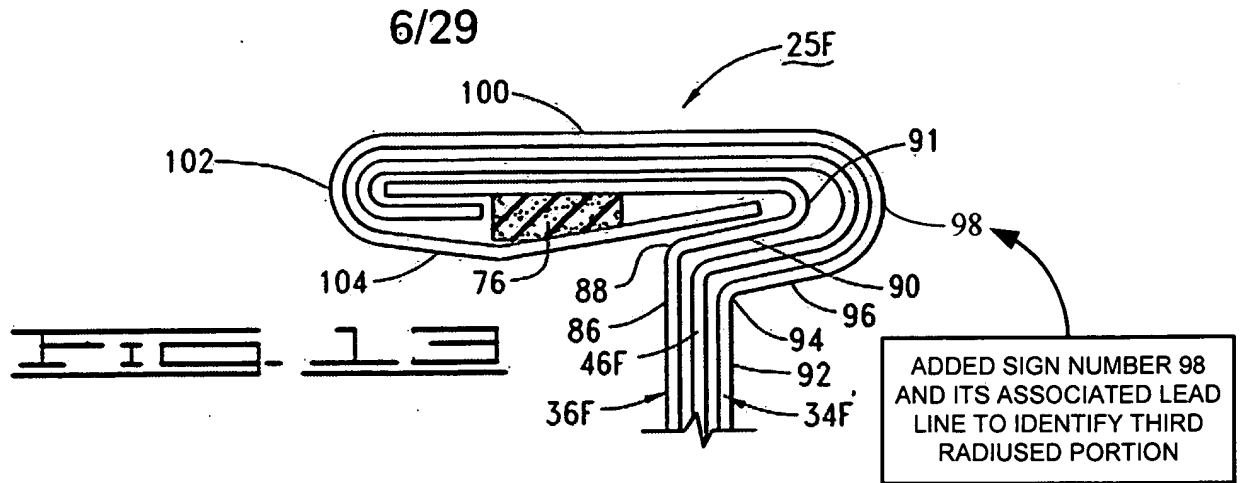
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### **Amendments to the Drawings**

The attached sheets of drawings include changes to FIGS. 13, 17, and 26. These sheets, which include FIGS. 13, 17, and 26, replaces drawing sheets 6, 7, and 11, which shows FIGS. 13, 17, and 26. FIG. 13 of drawing sheet 6, has been amended to include sign number 98, and its associated lead line, identifying the third radiused portion 98. FIG. 17 of drawing sheet 7, has been amended to show sign number 56, and its associated lead line, identifying the inner male portion instead of the outer female portion and to include sign number 68 and its associated lead line, to identify the fifth leg portion. FIG. 26 of drawing sheet 11, has been amended to show sign number 36F to correct a typographical error.

No new matter has been introduced by the amendment to FIGS. 13, 17 and 26 of drawing sheets 6, 7 and 11.

Attachments:            Replacement Sheets  
                              Annotated Sheets Showing Changes





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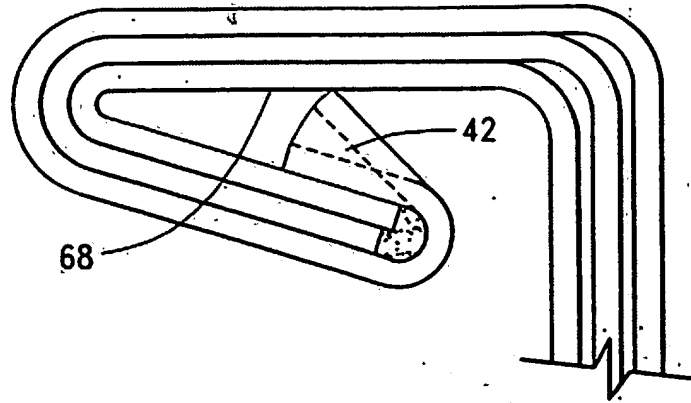


FIG. 16

ADDED SIGN NUMBER 68  
 AND ITS ASSOCIATED  
 LEAD LINE TO IDENTIFY  
 THE FIFTH LEG PORTION

REPLACED SIGN NUMBER 56  
 AND ASSOCIATED LEAD LINE  
 TO SHOW THE INNER MALE  
 PORTION INSTEAD OF OUTER  
 FEMALE PORTION

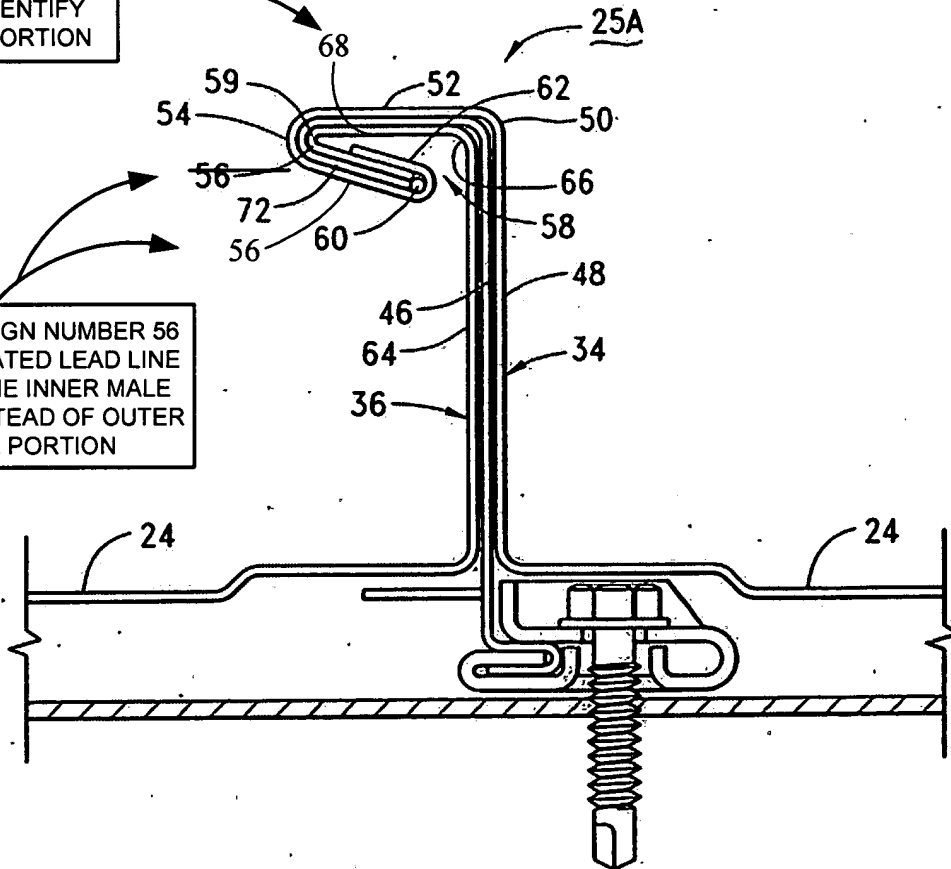


FIG. 17



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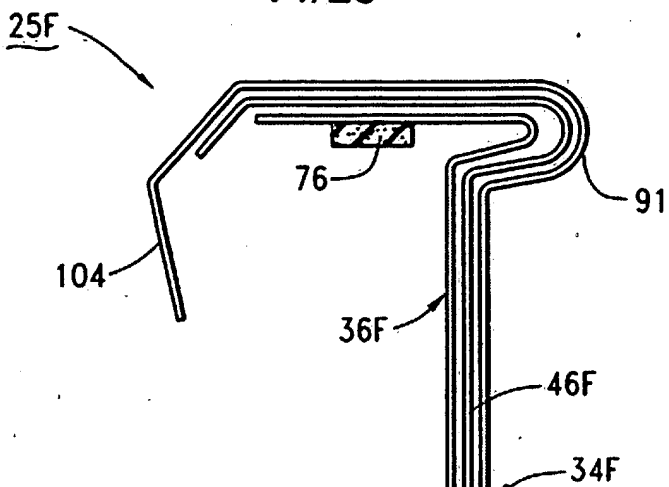


FIG. 25

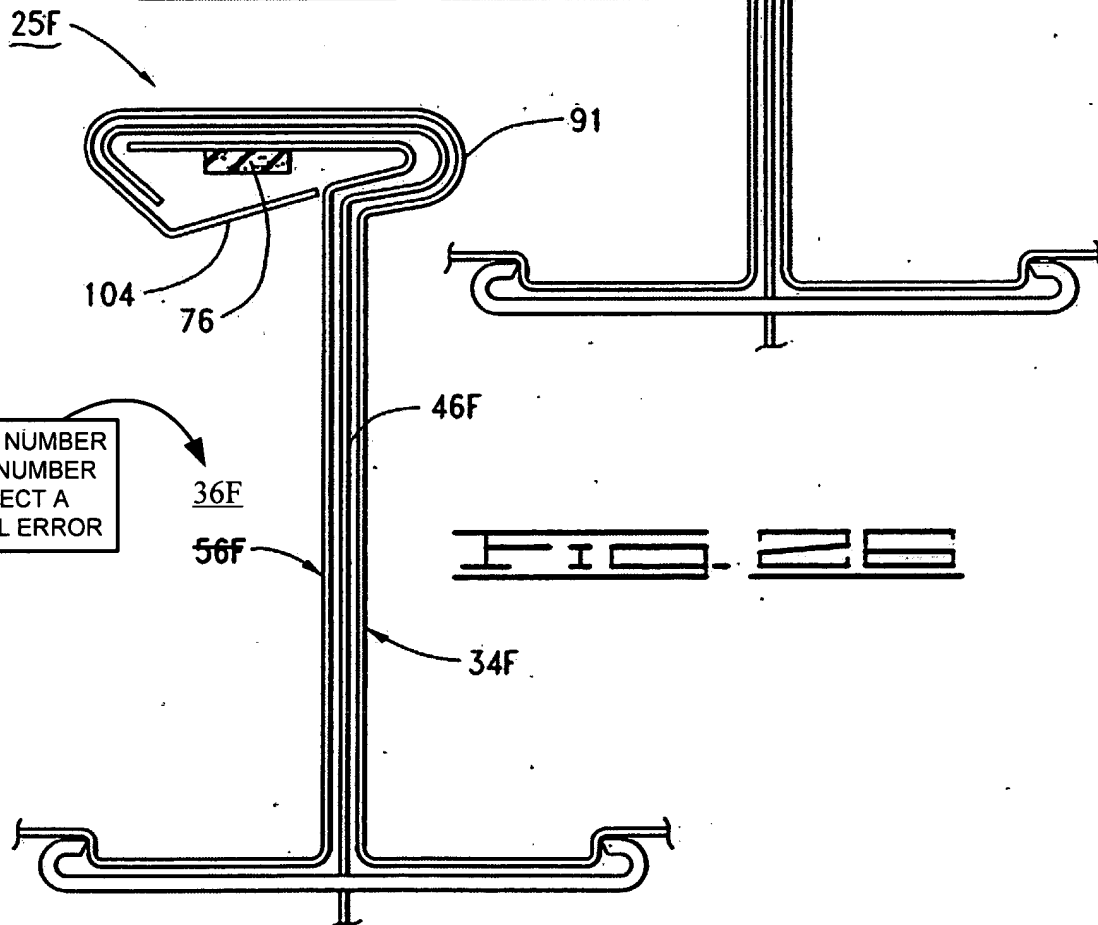


FIG. 26